

Remarks

Applicants greatly appreciate the recognition of patentable subject matter in the present application.

Applicants hereby add claims 22-26 and cancel claims 7 and 16. Accordingly, claims 1-6, 8-15, and 17-26 are pending in the present application.

Claims 16-17 stand rejected under 35 USC 112, second paragraph, for indefiniteness. Claims 1-13 stand rejected under 35 USC 101. Claims 1-4, 10-12, and 15 stand rejected under the judicially created doctrine of obviousness-type double patenting. Claims 5-9, 13-14, and 16-21 stand rejected under the judicially created doctrine of obviousness-type double patenting. Claims 1-4, 10-12, and 15 stand rejected under 35 USC 102(e) for anticipation over U.S. Patent No. 6,798,719 to Muta et al. Claims 5-9, 13-14, and 16-21 stand rejected under 35 USC 103(a) for obviousness over Muta.

Applicants respectfully traverse the rejections and urge allowance of the present application.

Referring to the objection to the drawings, Applicants submit a Figure 2 herewith. Applicants respectfully submit Figure 2 is supported at least by the teachings in the originally filed specification at page 9, lines 25+ and original claims 11-21. The addition of Fig. 2 provides conformance of the drawings with the originally-filed specification and claims in accordance with MPEP 2163.06 (8th ed., rev. 3) which provides that information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without adding new matter. Applicants respectfully request withdrawal of the objection to the drawings.

Referring to the indefiniteness rejections, Applicants have amended the language of claims 16 (limitations of claim 16 are now incorporated in claim 15) and 17 as indicated herein. Applicants respectfully submit the claims are definite and request withdrawal of the indefiniteness rejection.

The amendments made herein with respect to 112, second paragraph, now more positively express limitations which were previously inherent in such claim(s), and accordingly are not for the purpose of narrowing and do not effectively narrow the scope of any claim.

Referring to the 101 rejection, Applicants refer to *Ex Parte Carl A. Lundgren*,
PDNO. 10008291-1
Serial No.: 09/888,941
Amendment A

Appeal No. 2003-2088, regarding Application 08/093,516. A copy of the opinion may be found at <http://www.uspto.gov/web/offices/dcom/bpai/prec.htm>. Applicant submits the 101 rejection is improper in view of this decision as well as the following authority.

Applicant respectfully submits precedent of the Court of Appeals for the Federal Circuit makes clear the subject claims recite statutory subject matter. Applicant to the holdings of *In re State Street*, 47 USPQ2d 159 (Fed. Cir. 1998) and *In re AT&T*, 50 USPQ2d 1447 (Fed. Cir. 1999). Further, 35 USC 101 states any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, is patentable. As recognized by the *State Street* court, the repetitive use of the term "any" in section 101 shows *Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in section 101*. The court further stated that it is improper to read limitations into section 101 on the subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations. See *State Street*, 47 USPQ2d at 1600.

The Federal Circuit has stated in the above-recited opinions that claims directed toward a useful, concrete or tangible thing or result recite statutory subject matter. *In re Alappat*, 33 F.3d at 1526, 31 USPQ2d 1545 (Fed. Cir. 1994) requires examination of the claims to determine whether the claimed subject matter as a whole is a disembodied mathematical concept representing nothing more than a law of nature or an abstract idea (non-statutory), or if the mathematical concept has been reduced to some practical application rendering it useful (statutory). *In re Alappat*, 31 USPQ2d at 1544.

Accordingly, Applicant's claims are clearly not merely reciting an abstract idea but rather recite practical applications which are useful, concrete and tangible results (i.e., the defining, generating and storing of claim 1 and the defining, searching, generating, encrypting, storing and outputting of claim 13) which are held to recite statutory subject matter. Applicant submits that abstract ideas are defined in *AT&T* as *mathematical subject matter which stands alone and which has not been reduced to some type of practical application*. *AT&T*, 50 USPQ2d at 1451. Applicant submits that in view of the above, the subject matter of the present application is not mathematical subject matter which stands alone but

PDNO. 10008291-1
Serial No.: 09/888,941
Amendment A

rather has clearly been reduced to practical applications which are useful. Applicants respectfully request withdrawal of the 101 rejections for at least the above-mentioned reasons.

Referring to the double patenting rejections, Applicant submits a terminal disclaimer herewith and respectfully request withdrawal of the double patenting rejection in view of the submitted terminal disclaimer.

Referring to the prior art rejections, Applicants respectfully submit the use of Muta as prior art in support of the obviousness rejections is improper under Section 35 U.S.C. §103(c). More specifically, as evidenced by the Statement of Common Ownership submitted herewith, Muta and the above-referenced application are commonly owned. MPEP §706.02(I)(3) (8th ed., rev. 3) states that Muta is disqualified when:

(a) proper evidence is filed (see the statement of common ownership filed herewith);

(b) the reference qualifies as prior art under 35 U.S.C. §102(e) for applications filed on or after November 29, 1999; and

(c) the reference is used in an obviousness rejection under 35 U.S.C. §103(a).

The Muta reference qualifies as a §102(e) reference and is used in an obviousness rejection against some of the pending claims. Moreover, the above-referenced application was filed after the November 29, 1999 deadline. Accordingly, the requirements of MPEP §706.02(I)(3) (8th ed., rev.3) and §103(c) are met and the obviousness rejection against the claims based on Muta is inappropriate and should be withdrawn.

More specifically, referring to claim 1, the method recites limitations of previously pending claim 7. Applicants respectfully submit the 103 rejection against previously pending claim 7 was improper under 103(c) and Applicants respectfully request allowance of claim1 for at least this reason.

The claims which depend from independent claim 7 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by

PDNO. 10008291-1
Serial No.: 09/888,941
Amendment A

the cited art.

Referring to claim 13, Applicants respectfully submit the 103 rejection of claim 13 is improper under 103(c) and Applicants respectfully request allowance of claim 13 in the next Action.

The claims which depend from independent claim 13 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 15, the method recites limitations of previously pending claim 16. Applicants respectfully submit the 103 rejection against previously pending claim 16 was improper under 103(c) and Applicants respectfully request allowance of claim 15 for at least this reason.

The claims which depend from independent claim 15 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 21, Applicants respectfully submit the 103 rejection of claim 21 is improper under 103(c) and Applicants respectfully request allowance of claim 21 in the next Action.

Applicants hereby include new claims 22-26 which include limitations of originally pending claims 5, 6, 18, 19, and 20 and the limitations of the respective base claims thereof. New claims 22-26 are believed to be allowable pursuant to 35 USC 103(c) discussed above and allowance of the claims is respectfully requested in the next Action.

In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R. §1.104(c)(2). In particular, 37 C.F.R. §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. *When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as*

PDNO. 10008291-1
Serial No.: 09/888,941
Amendment A

13

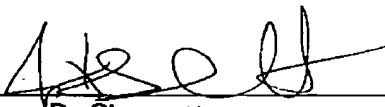
practicable. Applicants respectfully request clarification of the rejections with respect to specific references and specific reference teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if any claims are not found to be allowable.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,
Theresa A. Burkes et al.

By:


James D. Shaurette

Reg. No. 39,833

Date: 12/19/05

PDNO. 10008291-1
Serial No.: 09/888,941
Amendment A